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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,874	06/11/2002	Yasuo Tano	112372	4957

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Oliff & Berridge  
P O Box 19928  
Alexandria, VA 22320

EXAMINER

WEBB, SARAH K

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/088,874

Applicant(s)

TANO, YASUO

Examiner

Sarah K Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/23/04</u>   | 6) <input type="checkbox"/> Other: _____                                    |

DETAILED ACTION

*Claim Objections*

1. Claim 1 is objected to because of the following informalities:

Claim 1: "poring" in line 7 should be "portion."

Claims 9 and 11- 15 have preambles that differ from the independent claim. The preamble should not differ between the independent claim and claims that depend from it.

Claim 14: the phrases "the engaging portions" in line 2 and "the ring shape" in line 4 have no antecedent basis.

Claim 15: "the ring shape" in line 3 has no antecedent basis.

Appropriate correction is required.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4,8, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,171,254 to Sher.

Sher discloses a device that includes eyelid opener portions (22) and a holding portion (61). Engaging portions (66) on the holder (61) connect with connection portions (24) on the eyelid openers and include holes (24) that are shown in Figure 2. The phrases "for holding the vitreous body..." and "wherein the vitreous body surgical contact lens is held on the eyeball" recite only functional language or intended use. If the device is Sher is

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capable of performing these functions, it meets the limitations of the claims. Even though the ring shaped holding portion (61) of Sher is not disclosed as being a lens holder, it is capable of performing this function.

The eyelid openers are biased apart by a spring (34). The holding portion and eyelid openers are connected in an adjustable manner, as they are removable from one another. Sher states that it's obvious to use various forms of connection means, such as hook and loop structure, between the holding portion (61) and eyelid openers (22) (column 3, lines 13-26).

3. Claims 1,2,4,5,10 rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,556,417 to Sher.

Sher discloses a device that includes eyelid opener portions (22) and a holding portion (61). Connecting portions (44,42,40) attach the ring (61) to the eyelid openers and an elastic member (36) is included in this connection means. Figures 2, and 2A show more clearly that the ring (61) is chamfered. Sher explains that the position between the ring (61) and openers (22) is adjustable (lines 30-37).

The phrases "for holding the vitreous body..." and "wherein the vitreous body surgical contact lens is held on the eyeball" recite only functional language or intended use. If the device is Sher is capable of performing these functions, it meets the limitations of the claims. Even though the ring shaped holding portion (61) of Sher is not disclosed as being a lens holder, it is capable of performing this function.

Sher does include an adjustable mechanism in the form of a collar and set screw (26,32) for connecting the eyelid openers.

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*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6,7, and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sher '254.

Sher fails to form the adjustable connection portions between the ring (61) and the eyelid openers (22) to include a closed loop of elastic silicone rubber. Sher teaches that any type of alternative equivalent mechanical attachment mechanism could be used to secure the ring (61) to the eyelid openers (column 7, lines 13-27). Sher even states that a hook and loop, or Velcro, mechanism could be used. Applicant has not specified that the rubber loop connection mechanism solves any particular problem or has any functional advantages over other attachment mechanisms known in the art. Therefore, it would be obvious to simply tie the ring to the eyelid openers with a loop of silicone rubber. It would be an obvious matter of design choice to replace the sophisticated connection bars (68,66) on the ring of Sher with a simple loop of rubber, as Sher teaches that any mechanical attachment mechanism is suitable for attaching the ring to the eyelid openers.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sher '254 in view of US Patent No. 3,139,298 to Grabiell.

Sher fails to form the holding portion for the lens from a frosted material. Grabiell teaches that an apparatus for use near the eye should include a frosted surface so that

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reflection is prevented (column 3, lines 65-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a frosted surface on the Sher device, as taught by Grabiell, so that light is not reflected from the surface of the device during the procedure.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah K Webb whose telephone number is (571) 272-4706. The examiner can normally be reached on Mon-Fri 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhthuan T. Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SKW

2/18/05



JULIAN W. WOO  
PRIMARY EXAMINER